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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/402,796	12/22/1999	CHRISTINE DUPUIS	05725.0481	6460

7590 11/27/2002  
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WASHINGTON, DC 20005

EXAMINER

WELLS, LAUREN Q

ART UNIT	PAPER NUMBER
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1617

DATE MAILED: 11/27/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/402,796

Applicant(s)

DUPUIS, CHRISTINE

Examiner

Lauren Q Wells

Art Unit

1617

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 24 October 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 16-37 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 16-37 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

### **DETAILED ACTION**

Claims 16-37 are pending. The Amendment filed 10/24/02, Paper No. 24, amended claims 16, 27, 30-33, and 35-37.

#### ***Response to Applicant's Arguments/Amendment***

The Applicant's arguments filed 10/24/02 (Paper No. 24) to the rejection of claims 16-37 made by the Examiner under 35 USC 103 have been fully considered and deemed not persuasive.

The Applicant's arguments and amendment filed 10/24/02 is sufficient-in-part to overcome the 35 USC 112 rejections in the previous Office Action. See below for details.

The Terminal Disclaimer filed 10/29/02, Paper No. 25, is sufficient-in-part to overcome the double patenting rejections in the previous Office Action. See below for details.

#### ***Double Patenting Rejection Maintained***

The rejection of claims 16-37 under the judicially created doctrine of double patenting as being unpatentable over 6,030,392 and 09/265,580 is MAINTAINED for the reasons set forth in the Office Action mailed 7/31/02, Paper No. 22, and those found below.

Regarding 6,080,392, Applicant argues, "Independent claim 1 of Dupuis requires that the composition is pressurized in the presence of a propellant and is capable of forming a mousse. In contrast the claims of the present invention do not require (1) that the composition is pressurized as an aerosol, the (2) the presence of a propellant, and (3) that the composition is capable of forming a mousse". This argument is not persuasive. The Examiner respectfully points out that both '392 and the instant application have claims directed to a composition. While the instant application may not require a special bodily form, the instant invention and '392 still teach the

Art Unit: 1617

same composition. Furthermore, '392 and the instant invention are both directed to hair care composition. Since mousses are well known hair composition formulations, one of skill in the art would be motivated to deliver the composition of the instant invention as a mousse.

Regarding 09/265,580 (now US Patent No. 6,383,473), Applicant argues, "Independent claim 1 of US Patent No. 6,383,472 requires that the composition is pressurized as an aerosol in the presence of a propellant and is capable of forming a mousse. In contrast the claims of the present invention do not require (1) that the composition is pressurized as an aerosol, (2) the presence of a propellant, and (3) that the composition is capable of forming a mousse". This argument is not persuasive. See above paragraph, wherein the Examiner responds to the same arguments.

### ***112 Rejection Maintained***

The rejection of claims 21, 22, 26 and 29 under 35 U.S.C. 112 is MAINTAINED for the reasons set forth in the Office Action mailed 7/31/02, Paper No. 22, and those found below.

(i) The rejection of the phrase "chemically, enzymatically or microbiologically modified soluble starch" in claim 21 is maintained. The specification does not disclose what these starches are and one of skill in the art would not be able ascertain what compounds are encompassed by this phrase, as this phrase encompasses an innumerable amount of chemical possibilities and hence, compounds.

(ii) The rejection of the term "derivatives" in claims 22, 26, and 29 is maintained. The specification does not define these terms and one of skill in the art would not be apprised of all the chemical modifications encompassed by this term.

Art Unit: 1617

***103 Rejection Maintained***

The rejection of claims 16-37 under 35 U.S.C. 103(a) as being unpatentable over Dupuis (6,080,392) in view of Emmons et al. (4,155,892) in further view of Prencipe et al. (5,385,729) is MAINTAINED for the reasons set forth in the Office Action mailed 7/31/02, Paper No. 22, and those found below.

Applicant argues, "Specifically, Dupuis does not teach or suggest that the end units should have 1 to 6 carbon atoms on one end and 8 to 18 carbon atoms on the other end, as presently claimed. Moreover, the Examiner has failed to establish that Dupuis provides any motivation for having a compound with end units of different carbon length". This argument is not persuasive. First, the Examiner respectfully points out that the rejection was made in combination with two other references, wherein the secondary references teaches the possibility of having 1 to 6 carbon atoms. Second, the Examiner respectfully points out that even in teaching formula (IV), Dupuis states that "R" and "R'" may be identical or different. Thus, Dupuis teaches polyurethanes wherein the end capping hydrocarbon chains are of different lengths.

Applicant argues, "the Examiner has not established why one of ordinary skill in the art would have been motivated to modify Dupuis' polyether polyurethane". This argument is not persuasive. The Examiner respectfully points out that Emmons et al. teach that by altering the length of the hydrocarbon chains in the polyurethane, a preferred thickness of a composition can be obtained. Thus, one of skill in the art would be motivated to alter the chain length of the hydrocarbon chains in formula (IV) of Dupuis to achieve a composition with a preferred thickness.

Art Unit: 1617

Applicant argues, “Emmons does not teach or suggest that a compound should have one end unit with lower alkyl groups and another with higher alkyl groups, let alone specifically teach or suggest one end unit with 1 to 6 carbon atoms and the other with 8 to 18 carbon atoms”. This argument is not persuasive. First, the Examiner respectfully points out that Emmons is not a stand alone reference, but is a secondary reference. Thus, Emmons is not required to teach all the limitations of the instant claims. The Examiner respectfully points out that Emmons is relied upon for its teaching that altering carbon chain length of polyurethanes is known, as are chain lengths of less than eight carbons.

Applicant argues, “While Emmons teaches compounds with similar ends, Emmons does not provide any evidence of the thickening properties of a compound with one lower alkyl group and one higher alkyl group”. This argument is not persuasive. The Examiner respectfully points out that Emmons et al. teach that by altering the chain length of the hydrocarbon chains of the polyurethane, the thickness of a composition is altered. Since, Dupuis teaches that the end capping hydrocarbon chains can be of different length, it would have been obvious to one of skill in the art at the time the invention was made to alter the chain lengths of the end capping hydrocarbon chains because of the expectation of achieving a preferred composition thickness.

### ***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after

Art Unit: 1617

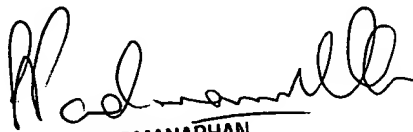
the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lauren Q Wells whose telephone number is (703) 305-1878. The examiner can normally be reached on M-F (7-5:30), with alternate Mondays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sreeni Padmanabhan can be reached on (703)305-1877. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9306 for regular communications and (703) 872-9307 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1234.

lqw  
November 20, 2002

  
SREENI PADMANABHAN  
PRIMARY EXAMINER  
11/24/02